

## **REMARKS**

This Amendment is responsive to the Office Action dated November 14, 2002. Claims 18-22 have been withdrawn from consideration as subject to a Restriction Requirement. Claims 1, 6, 11-13, 16 and 17 have been amended herewith, without prejudice. Claim 15 has been cancelled herewith, without prejudice.

Please charge any additional fees or credit any overpayment in connection with this response to our Deposit Account No. 01-1960. A duplicate copy of this letter is enclosed for that purpose.

### **I. INTRODUCTION**

The specification is objected to as failing to provide proper antecedent basis for the following claimed subject matter: "means for providing," "active comparison," and "information." Claims 6, 8-17 are rejected under 35 U.S.C. 112, second paragraph. Claims 1-3, 5, 6, and 13-15 are rejected under 35 U.S.C. 102(b). Claim 7 is rejected under 35 U.S.C. 103(a).

### **II. SPECIFICATION OBJECTION**

The specification is objected to as failing to provide proper antecedent basis for the following claimed subject matter: "means for providing," "active comparison," and "information."

The specification has been amended in two places to further clarify the nomenclature used in the claims. First, the following sentences were added to the paragraph starting on page 10, line 15 (emphasis added): [t]he device 10 provides the golfer with an active comparison between device 10-target T alignment and golfer body-target T alignment. In this way, the laser beam 32 provides the golfer with a swing alignment reference separate from the golfer's body. The sentences were added to further clarify the term “active comparison.” Support for the foregoing amendment is found throughout the patent document and in the claims as originally filed, and more specifically in the preceding paragraph on page 10, lines 11-12 where “[t]he golfer can then compare his stance to the properly aligned laser beam 32, . . . ”

Second, the following text was added to the paragraph starting on page 12, line 7 (emphasis added): [a]s laser beam 32 provides the golfer with a visual indication of swing alignment, . . . ” The term “indication” is intended to replace the less definite term “information” in the claims. The “indication” is a visual indication of the swing alignment, or alternatively how the body is aligned during the swing, in a preferred embodiment. Support for this amendment can be found throughout the patent document and in the claims as originally filed. More specifically, on page 7, lines 22-24, “[b]y using and controlling where the laser beam 32 points, the golfer G is able to achieve proper body alignment in reference to target T.” The key terms “using and controlling where the laser beam 32 points,” are the visual indication.

The subject matter “means for providing” was also objected to as not having sufficient antecedent basis in the specification. The Applicant respectfully points out that the claimed subject matter is not merely “a means for providing.” Rather, the claimed subject matter is “a means for providing an active comparison with an external reference.”

Title 35, section 112, paragraph six specifically permits “an element in a claim for a combination [to] be expressed as a means or step for performing a specified function.” Such a claim element defines the function of the element, rather than its structure. The statute then provides that such a claim element “shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”

The function of this claim element is not merely “providing,” but “providing an active comparison with an external reference.” Antecedent basis for this claim element is found throughout the patent document, and more specifically, page 10, lines 10-14, where laser beam 32 is a means for providing an active comparison with an external reference, and in the claims as originally filed.

### **III. CLAIM REJECTIONS UNDER 35 U.S.C. 112**

Claims 6, 8-17 are rejected under 35 U.S.C. 112, second paragraph as being indefinite.

Claim 6 has been amended to depend from claim 5.

Regarding claim 8, the Office Action points out that an article of clothing can't clearly be an affixing means. The claim has been amended so that a location on the golfer's body is further an article of clothing worn by the golfer.

Regarding claims 9 and 10, the Office Action based the rejection on Applicant claiming portions of a person's body as an apparatus. Applicant respectfully traverses the rejection because the location on the person's body is not the claimed structure, but rather is used to define the element functionally using means-plus-function claim language.

The claimed structure is "a means for affixing the housing to a location on a golfer's body." Claims 9 and 10 further limit the location on a golfer's body to the golfer's left ankle or waist. Applicant is not claiming a golfer's ankle or waist as structure in an apparatus claim, but rather, the terms are used to help describe functionality.

Claim 11 has been amended to more clearly define the subject embodiment. New matter has not been added.

Claim 12 is rejected as attempting to claim the ground as part of the device. Similar to the foregoing discussion, the ground is not being claimed as structure of the device. Rather the ground is used to describe functionality.

The difference from claims 9 and 10 is that claim 12 does not further limit a means-plus-function claim element. However, functionality is commonly used in patent practice to define structure. SEE MPEP §2173.05(g). "A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step."

In this case, the functional limitation is "wherein the laser emits a laser beam for providing the golfer with a swing alignment reference separate from the golfer's body." This is further limited by claim 12, "wherein the reference is a point of reference directly on the ground in between the golfer's feet." Therefore, "the ground" is not recited structure, but instead further defines functionality. Applicant respectfully asserts that claim 12 is clear and definite.

Claims 13-17 were rejected as being unclear. In particular the Office Action cites "information" in claims 13, 16, and 17 as not being understood. As stated under Part I of this Remarks Section, claims 13, 16 and 17 were amended to replace "information" with "an indication" regarding swing alignment. In a preferred embodiment, the laser beam 32 provides a visual indication of swing alignment with respect to an external reference, or more specifically, a target T.

Applicant respectfully asserts that claim 14 is clear and definite as written and depending from amended claim 13. Claim 14 further limits "a means for

providing,” as providing a laser beam, which in turn, provides “an active comparison,” “wherein the active comparison provides the golfer with information regarding how his swing is aligned before, during or after a golf swing.” Claim 15 is cancelled herein, without prejudice.

#### **IV. CLAIM REJECTIONS UNDER 35 U.S.C. 102(b)**

Claims 1-3, 5, 6 and 13-15 are rejected as being clearly anticipated by Jehn (5,284,345). To evidence anticipation of a claimed invention, a single prior art reference must disclose every element of that claimed invention, as in the claim. Jehn teaches a golf training device that is fastened to a visor and aligns a laser beam at a golf ball. In no way does Jehn teach or suggest aligning a laser beam at an external reference such as a target, nor does any other cited reference. Claim 1 has been amended to more clearly point out that the laser beam points directly to an external reference, such as a target (claim 11) or a point on the ground between the golfer’s feet (claim 12).

Applicant respectfully asserts that independent claim 1 is patentable for the reasons set forth above. Further, since claims 2, 3, 5, 6, and 13-15, depend either directly or indirectly from claim 1, these claims are likewise allowable both for their dependency on allowable claim 1, and for the limitations claimed therein.

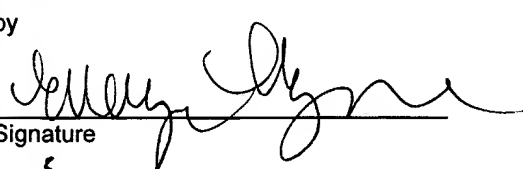
**V. CLAIM REJECTIONS UNDER 35 U.S.C. 103(a)**

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jehn in view of Cannone (4,406,040). Applicant respectfully asserts that independent claim 1 is patentable for the reasons set forth above. Further, since claim 7 depends indirectly from claim 1, this claim is likewise allowable both for its dependency and its own additional limitations.

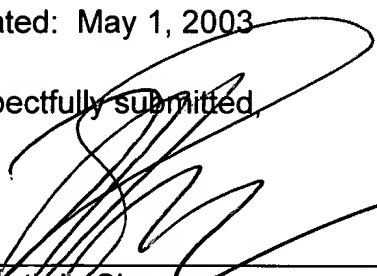
**VI. SUMMARY**

Based on the above amendments and accompanying remarks, Applicant respectfully submits that all pending claims are in condition for allowance and earnestly solicits a notice thereof. Applicant encourages the Examiner to telephone the undersigned attorney if it appears that a telephone conference would facilitate allowance of the application.

Dated: May 1, 2003

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on	
May <u>5</u>	2003
by	
	
Signature	
May <u>5</u>	2003

Respectfully submitted,

  
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Kenneth L. Sherman  
Registration No. 33,783  
Myers Dawes Andras & Sherman  
2029 Century Park East, Suite 1700  
Los Angeles, CA 90067  
(310) 789-3200

**ATTACHMENT**

**Version With Markings To Show Changes Made**

**The specification has been amended as follows:**

<b>Paragraph</b>	<b>Replacement Paragraph with Changes Shown</b>
Page 10, lines 15-18:	<p>An advantage of the preferred embodiment of the present invention is that the golfer can use the device 10 as an aid each time he is ready to take a swing. <b><u>The device 10 provides the golfer with an active comparison between device 10-target T alignment and golfer body-target T alignment. In this way, the laser beam 32 provides the golfer with a swing alignment reference separate from the golfer's body.</u></b> Repetition of the above process should lead the golfer to perfecting his body alignment in relation to the target T.</p>



Paragraph	Replacement Paragraph with Changes Shown
Page 12 line7-14:	<p>Further embodiments of the present invention are also envisioned. For example, it is envisioned that the laser alignment device discussed above can be included directly into the golfer's clothes so that the proper placement on the golfer's body is ensured. <b><u>As laser beam 32 provides the golfer with a visual indication of swing alignment</u></b> Furthermore, other forces such as magnetics or sound may be used within the scope of the presently claimed invention which allow a golfer to interactively coordinate his swing and stance with an external reference system. Additionally, the preferred embodiment of the present invention can be modified to provide an automated sound or light signal to describe when the point of reference is in or out of alignment.</p>

## IN THE CLAIMS

Please cancel claim 15, without prejudice.

Please substitute the following claims for the pending claims of the same number:

1 1. (Amended) A golf laser aid device comprising:  
2 a housing having a laser; and  
3 a means for affixing the housing to a location on a golfer's body,  
4 wherein the laser emits a laser beam **that points in a line directly**  
5 **toward an external reference** for providing the golfer with a swing alignment  
6 reference separate from the golfer's body.

1 6. (Amended) The device of Claim 4 5, wherein the fastening means  
2 comprises an adjustable velcro strap.

1 8. (Amended) The device of Claim 1, wherein the ~~means for affixing~~  
2 **location on the golfer's body** is an article of clothing worn by the golfer.

1 11. (Amended) The device of Claim 1, wherein the **external** reference  
2 is a ~~laser beam pointing in line directly to a target~~.

1 12. (Amended) The device of Claim 1, wherein the **external** reference  
2 is a point of reference directly on the ground in between the golfer's feet.

1 13. (Amended) A golfer's aid, comprising:  
2 a means for providing an active comparison with an external reference,  
3 the external reference being separated from a golfer's body; and

4 an affixing means for affixing the means for providing an active  
5 comparison with an external reference to the golfer's body;  
6 wherein the active comparison provides the golfer with information an  
7 indication regarding how his swing is aligned before, during or after a golf  
8 swing.

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1 16. (Amended) The aid of Claim 13, where the information indication  
2 is a visual reference.

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1 17. (Amended) The aid of Claim 13, where the information indication  
2 is a sound signal indicating proper stance.